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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/781,296	01/13/1997	JOHN B. HARLEY	OMRF161	8073
32425	7590	02/03/2006	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			CLOW, LORI A	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/781,296	Applicant(s) HARLEY ET AL.	
	Examiner Lori A. Clow, Ph.D.	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27 and 29-40 is/are pending in the application.
4a) Of the above claim(s) 30-40 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 27 and 29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicants' arguments, filed 9 November 2005, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 27, and 29-40 are currently pending. This application contains claims 30-40 drawn to an invention nonelected with traverse in Paper No. 10/20/1999. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

It is noted that Applicant has claim 35 listed as "currently amended". This is an incorrect status identifier, as there are no amendments to this claim.

Claim Rejections - 35 USC § 112-Written Description

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27 and 29 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is maintained, for the reasons set forth in the previous Office Action.

Response to Applicant Arguments

1. Applicant argues that the “present application describes a variety of peptides that can be used to screen for antibodies in subjects potentially infected with EBV and afflicted with an autoimmune disorder”.

This is not persuasive, as Applicants arguments are directed to a method of screening, which is not a limitation of the claims under consideration (claims 27 and 29). The claims under consideration are drawn to a product, specifically a peptide composition.

2. Applicant argues that “those of skill in the art readily understand that the recited peptide sequences maybe included within larger peptide segments (but not longer than about 40 amino acids, as recited) while still accomplishing the goals of the present invention. The Examiner has made no effort to establish why one of skill in the art would not immediately comprehend that the sequences beyond those recited can be virtually any other peptide sequence”.

This is not persuasive, as the Examiner clearly cited a prima facie case by citing the specification and the relevant controlling law. Applicant is invited to review the previous Office Action, as pages 2 to 3, which outline the failure of the specification to provide written description of the genus encompassed by the claim.

Further, Applicant is reminded that “an Applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an

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actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998). Further, a patentee of a biotechnical invention cannot necessarily claim a genus after only describing a limited number of species because there may be unpredictability in the results obtained from species other than those specifically enumerated.

In the instant case, Applicant has failed to show support in the original disclosure or the originally filed claims for the combinations, as recited in claims 27 and 29.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27 and 29 remain rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (*Virology* (1994) Vol. 205, pages 486-495). Chen et al. disclose a peptide molecule consisting of about 40 amino acids or less and comprising the peptide sequence GKHRGQGGSN (SEQ ID NO: 28; page 489, Figure 1(A)).

Chen et al. disclose a peptide molecule consisting of about 40 amino acids or less and comprising the peptide sequence QGGSNPK (SEQ ID NO: 29; page 489, Figure 1(A)).

Chen et al. disclose a peptide molecule consisting of about 40 amino acids or less and comprising the peptide sequence NPKFENIA (SEQ ID NO: 30; page 489, Figure 1(A)).

Response to Applicant's Arguments

Chen Rejection

Applicant's arguments with regard to SEQ ID NOS:28-30 of claims 27 and 29 are not persuasive. The sequence of Figure 1A is a protein in which comprises SEQ ID NOS 28, 29, and 30 of the instant claims. Claims 27 and 29 are drawn to a peptide composition comprising a peptide molecule. Therefore, the peptide sequence within a larger sequence of Chen meets the limitations of the instant claims.

Middeldorp Rejection

Applicant arguments with regard to SEQ ID NO: 22 of claims 27 and 29 are persuasive. It is acknowledged that Middeldorp's SEQ ID NO:5 does not contain the terminal glycine residue of Applicant's SEQ ID NO:22. Applicant SEQ ID NO:22 has a cysteine at the terminal position. The rejection is hereby withdrawn.

Ebihara, Stuber(1995), and Stuber (1992) Rejections

The rejections over Ebihara, Stuber (1995), and Stuber (1992) have been withdrawn in view of Applicant's cancellation of the relevant sequences.

Conclusion

Claims 27 and 29 remain rejected under 35 USC 112, 1st paragraph for lack of Written Description.

The following sequences appear to be free of the prior art: SEQ ID NOs: 1, 2, 3, 13, 14, 17-19, 21-22, 25-27, 31-33, 36, and 38.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (571) 272-0715. The examiner can normally be reached on Monday-Friday from 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D., can be reached on (571) 272-0718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are

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available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

February 1, 2006
Lori A. Clow, Ph.D.
Art Unit 1631
Lori A. Clow

MKE
MARY K. ZEMAN
PRIMARY EXAMINER
W1631
2/1/06